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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,373	10/29/2001	Hiroshi Sasaki	01697/LH	1645

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EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,373

Applicant(s)

SASAKI ET AL.

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This Office Action is in response to an amendment filed 29 April 2003 in paper number 10 in which claims 10-11 were amended, claims 12-27 were added and claims 1-9 were cancelled. Claims 10-27 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoeppe et al., U.S. Patent No. 6,167,173, in view of Yanagawa, U.S. Patent No. 5,287,367.

Schoeppe et al. disclose a laser microscope (fig. 1), which irradiates a sample (5) with a laser light (13.2) constituted of a plurality of emission wavelengths (column 3, lines 15-22) through an objective lens (4), and detecting a fluorescent light from the sample (column 3, lines 49-57), said laser microscope comprising: a spectral resolution section (21) configured to spectrally resolve said laser light; a light receiving element array configured to receive the laser lights spectrally resolved by the spectral resolution section (19); a controller (36, 34) configured to receive an output signal of the light receiving element array and controlling said laser light for each of said emission wavelengths (column 4, lines 1-7) and wherein said controller receives the output signal of said light receiving element array and simultaneously controls respective light intensities of the plurality of emission wavelengths of said laser light to be constant and wherein

Art Unit: 2872

said controller configured to receive the output signal of said light receiving element array and outputting a control signal for simultaneously setting respective light intensities of the plurality of emission wavelengths of said laser light to be constant (column 4, lines 1-19); an acousto-optical element (AOTF within 13.2), disposed on an optical path of said laser light, configured to receive said control signal outputted from said control unit and setting the respective light intensities of the plurality of emission wavelengths of said laser light to be constant and an optical fiber (14.2) for guiding said laser light into a laser microscope main body wherein said spectral resolution section and said light receiving element array are disposed on a light emission side of said optical fiber (fig. 1); a collimator lens (16) configured to collimate said laser light guided by the optical fiber; and a beam splitter (18) configured to split a part of said laser light and guiding the part into said spectral resolution section.

Schoeppe et al. disclose the claimed invention except for wherein said spectral resolution section is any one selected from a group including of a prism, a diffraction grating, and a beam splitter; wherein said light receiving element array comprises either one of a split photodiode and a solid-state image sensing device; wherein a converging lens is disposed between said spectral resolution section and said light receiving element array and configured to converge the spectrally resolved laser lights on said light receiving element array for the respective emission wavelengths; wherein said collimator lens, said beam splitter, said spectral resolution section, said converging lens, and said light receiving element array are formed into one block, and the block is constituted to be attachable/detachable with respect to a main body of said laser microscope; and wherein the light receiving element array includes a plurality of light receiving elements configured to receive said spectrally resolved laser light such that each emission

Art Unit: 2872

wavelength is respectively received by one of said light receiving elements. Yanagawa teaches a laser with a wavelength detection/comparison unit (43, figs. 4-9) with a spectral resolution section (431 or 432) that is any one selected from a group including of a prism, a diffraction grating, and a beam splitter; and a light receiving element array (431b or 433a and 433b or 432b), which is a plurality of light receiving elements, and wherein the light receiving element array comprises a split photodiode; wherein a converging lens (432a, fig. 8) is disposed between said spectral resolution section and said light receiving element array and configured to converge the spectrally resolved laser lights on said light receiving element array for the respective emission wavelengths and wherein each emission wavelength is respectively received by one of said light receiving elements (fig. 4-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the wavelength detection/comparison unit of Yanagawa in the system of Schoeppe et al. to be able to enter a specific wavelength(s) value (S_5 , Schoeppe et al.) to which the system can be controlled. Further, the collimator lens (16) and beam splitter (18) of Schoeppe et al. with the spectral resolution section, the converging lens, and the light receiving element array of Yanagawa are formed into one block (within the scanning unit of the microscope), and therefore the block is constituted to be attachable/detachable with respect to a main body (M) of the laser microscope.

Response to Arguments

3. Applicant's arguments filed 29 April 2003 have been fully considered but they are not persuasive.

Regarding claims 10-11 and in response to applicant's argument that Yanagawa is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yanagawa states in column 1, lines 6-10 that "this invention relates to an apparatus for controlling a semiconductor laser used as a light source in various devices such as CD (compact disk) or LD (laser disk), etc." Yanagawa only cites a CD or LD system as an example of where the invention is useful. Clearly a microscope system is also a device which use lasers as light source and therefore within the field of endeavor and properly combinable.

Regarding claims 21-27, the applicant argues that original claim 2 was not rejected based on Schoeppe et al. The examiner disagrees. In paragraph 8 of the previous office action, claim 2 was addressed as being unpatentable over Schoeppe et al. in view of Yanagawa.

4. Applicant's arguments with respect to claims 12-20 have been considered but are moot in view of the new ground(s) of rejection.

5. It is noted by the Examiner that the objections to the specification made in the previous Office Action have been withdrawn due to amendment by the Applicant.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Application/Control Number: 10/006,373

Page 7


Art Unit: 2872

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF

July 26, 2003


MARK A. ROBINSON
PRIMARY EXAMINER